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10/011,857	11/05/2001	Debendra Das Sharma	10017812 - 1	5264

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HEWLETT-PACKARD COMPANY  
Intellectual Property Administration  
P.O. Box 272400  
Fort Collins, CO 80527-2400

EXAMINER

DANG, KHANH

ART UNIT

PAPER NUMBER

2111

DATE MAILED: 03/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.



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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

**MAILED**

Application Number: 10/011,857  
Filing Date: November 05, 2001  
Appellants(s): SHARMA, DEBENDRA DAS

**MAR 24 2006**  
**Technology Center 2100**

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Robert W. Bergstrom  
For Appellants

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 1/26/2006 appealing from the Office action mailed 7/21/2005.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellants's statement of the status of amendments after final rejection contained in the brief is correct. The 9/26/2005 after-final amendment including the new 1.131 Affidavit was NOT entered.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellants's statement of the grounds of rejection to be reviewed on appeal is correct.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

US 2002/0040414

Uehara et al.

4-2002

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1, 4-15 are rejected under 35 USC 102(e) as being anticipated by Uehara et al. (2002/0040414).

The detailed rejection is set forth in the 7/21/2005 Final Office Action.

**(10) Response to Argument**

**ISSUE 1:**

1. Whether claims 1 and 4-15 are anticipated by Uehara under 35 U.S.C. 102(e).

In response to the rejection of claims 1, 4-15 under 35 USC 102(e) over Uehara et al. (2002/0040414), Appellants, on 8/10/2004, submit a "Rule 131 Affidavit in which Applicant attests to submitting a disclosure of the current invention on June 11, 2001, prior to the July 3, 2001 filing date of Uehara. The Rule 131 Affidavit is supported by a dated disclosure document. In view of the Rule 131 Affidavit and supporting materials, Uehara is not citable under U.S.C. 102(e)."

**Appellants' new 1.131 Affidavit filed 9/26/2005 was NOT entered, since the entire after-final amendment 9/26/2005 including Appellants' new 1.131 Affidavit filed 9/26/2005 attached to Appellants' "Remarks" was NOT enter.**

The 8/10/2004 Affidavit and even the un-entered 9/26/2006 has not overcome the Uehara rejection because of the following reasons:

**At the outset, it is noted that Appellants concede that the invention was NOT reduced to practice.** In particular, Appellants argue that "Applicant did not state that the invention was reduced to practice, but instead stated that he conceived the invention prior to the date of the cited reference, and that, following conception, he diligently pursued a constructive reduction to practice." See Appeal Brief.

Appellants further argue that '[w]hether or not the invention was built and tested has no bearing on the establishment of prior invention. Applicant's representative has submitted exhibits, with a new STATEMENT OF FACTS ESTABLISHING DILIGENCE (as noted above, Appellants' new 1.131 Affidavit filed 9/26/2005 was NOT entered, since the entire after-final amendment 9/26/2005 including Appellants' new 1.131 Affidavit filed 9/26/2005 attached to Appellants' "Remarks" was NOT enter), that, following the invention disclosure dated June 12, 2001, prior to the effective date of the cited reference, Applicant's representative was contacted by the Assignee regarding preparation of the patent application on June 21, 2001, a signed representation agreement was submitted on August 15, 2001, transmittal of a draft of the patent application to the Inventor occurred on September 28, 2001, and a communication from

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the Assignee concerning signing of the declaration by the Inventor was forwarded on November 2, 2001, three days prior to filing of the Current Application

In short, constructive reduction to practice was diligently pursued by both the Inventor and the Assignee. Applicant's representative requests that the Examiner review 35 C.F.R. § 1.131 and reconsider the enclosed Rule 131 Affidavit, and supporting documents. Uchara is not prior art in view of the Rule 131 Affidavit and supporting documents, and cannot be cited in a 35 USC 102(e) rejection of the Current Application."

37 CFR 1.131(b) states that:

"(b) The showing of facts shall be such, in character and weight, as to establish reduction to practice prior to the effective date of the reference, or conception of the invention prior to the effective date of the reference coupled with due diligence from prior to said date to a subsequent reduction to practice or to the filing of the application. Original exhibits of drawings or records, or photocopies thereof, must accompany and form part of the affidavit or declaration or their absence must be satisfactorily explained."

Since Appellants concede that the invention was NOT reduced to practice, the remaining issue is whether the Affidavit shows "conception of the invention prior to the effective date of the reference coupled with due diligence from prior to said date to a subsequent reduction to practice or to the filing of the application."

According to MPEP 715.07 (III), in order to establish conception:

The affidavit or declaration must state FACTS and produce such documentary evidence and exhibits in support thereof as are available to show conception and completion of invention in this country or in a NAFTA or WTO member country (**MPEP § 715.07(c)**), at least the conception being at a date prior to the effective date of the reference.

However, the evidence submitted by Appellants' affidavit is insufficient to establish a conception of the invention prior to the effective date of the Uehara reference. While conception is the mental part of the inventive act, it must be capable of proof, such as by demonstrative evidence or by a complete disclosure to another. Conception is more than a vague idea of how to solve a problem. The requisite means themselves and their interaction must also be comprehended. See *Mergenthaler v. Scudder*, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897).

As required by MPEP 715.07, evidence to support "conception" is set forth below:

### **715.07 Facts and Documentary Evidence**

#### **GENERAL REQUIREMENTS**

The essential thing to be shown under **37 CFR 1.131** is priority of invention and this may be done by any satisfactory evidence of the fact. FACTS, not conclusions, must be alleged. Evidence in the form of exhibits may accompany the affidavit or declaration. Each exhibit relied upon should be specifically referred to in the affidavit or

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declaration, in terms of what it is relied upon to show. For example, the allegations of fact might be supported by submitting as evidence one or more of the following:

(A) attached sketches

**None is provided by Appellants**

(B) attached blueprints

**None is provided by Appellants**

(C) attached photographs

**None is provided by Appellants**

(D) attached reproductions of notebook entries

**None is provided by Appellants**

(E) an accompanying model

**None is provided by Appellants**

(F) attached supporting statements by witnesses, where verbal disclosures are the evidence relied upon. Ex parte Ovshinsky, 10 USPQ2d 1075 (Bd. Pat. App. & Inter. 1989)

**None is provided by Appellants**

(G) testimony given in an interference. Where interference testimony is used, the applicant must point out which parts of the testimony are being

relied on; examiners cannot be expected to search the entire interference record for the evidence. Ex parte Homan, 1905 C.D. 288 (Comm'r Pat. 1905)

**None is provided by Appellants**

and

(H) Disclosure documents (**MPEP § 1706**) may be used as documentary evidence of conception.

**None is provided by Appellants.**

Further, **37 CFR 1.131(b)** requires that original exhibits of drawings or records, or photocopies thereof, accompany and form part of the affidavit or declaration or their absence satisfactorily explained. In Ex parte Donovan, 1890 C.D. 109, 52 O.G. 309 (Comm'r Pat. 1890) the court stated.

**No satisfactorily explanation to the absence of facts and documentary evidence is provided by Appellants.**

To support "conception," Appellants only provide a one-page exhibit with only half page is directed to "Description of the construction and operation of the invention."

MPEP 715.07 states that "[h]owever, when reviewing a **37 CFR 1.131** affidavit or declaration, the examiner must consider all of the evidence presented in its entirety,

including the affidavits or declarations and all accompanying exhibits, records and "notes." An accompanying exhibit need not support all claimed limitations, provided that any missing limitation is supported by the declaration itself. *Ex parte Ovshinsky*, 10 USPQ2d 1075 (Bd. Pat. App. & Inter. 1989).

However, it is clear that a one-page exhibit filed 8/10/2004 can be used **as a substitution** of "facts and documentary evidence" required by MPEP 715.07.

In any event, the exhibit does NOT support all claimed limitations, and the missing limitations are NOT supported by the declaration itself. The limitations in claim 1 that are NOT supported by the 8/10/2004 exhibit are:

"transmitting back to the first electronic device [corresponding to the "source node" disclosed by the exhibit for sending a transaction/request] an ACK reply, and rejects requests transmitted from the first electronic device, transmitting back to the first electronic device a NAK reply;"

"storing by the first electronic device [corresponding to the "source node" disclosed by the exhibit for sending a transaction/request] a retry bit associated with each stored request;"

"maintaining a copy in storage, by the first electronic device [corresponding to the "source node" disclosed by the exhibit for sending a transaction/request], of each request until an ACK reply corresponding to the request is received by the second electronic device [corresponding to the "destination node" disclosed by the exhibit for receiving a transaction/request from the "source node"];

"employing the retry bits associated with each stored request by the first electronic device [corresponding to the "source node" disclosed by the exhibit for sending a transaction/request] to mark requests for retransmission; and

"employing the retry vector by the second electronic device [corresponding to the "destination node" disclosed by the exhibit for receiving a transaction/request from the "source node"] to mark a second set of electronic devices that need to retransmit one or more rejected requests."

## ISSUE 2

### 2. Whether claims 1-20 are indefinite under 35 USC § 112, second paragraph.

**At the outset, it is noted that Appellants submitted an amendment to the claims that are rejected under 35 USC 112, 2<sup>nd</sup> paragraph in the After-Final Amendment filed 9/26/2005. The After-Final Amendment filed 9/26/2005 was NOT entered. Without the After-Final proposed amendment, Appellants continue arguing with the Examiner regarding the 35 USC 112, 2<sup>nd</sup> paragraph issue.**

As evidenced by previous arguments presented by both Appellants and the Examiner, the Examiner and Appellants are in total disagreement regarding 35 USC 112, 2<sup>nd</sup> paragraph issue. It is still the Examiner's position that:

In claim 1, the amended terms "first set of electronic devices" and "second set of electronic devices" lack clear antecedent basis. It is unclear whether there are sets of "electronic devices" in addition to the first and second electronic devices, since the

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preamble only specifies a communication method between a first and second electronic devices.

In claim 9, the word “directly” is unclear. It appears that the first and second electronic devices are connected via an “electronic communications medium.” In other words, when there is a communications medium between the devices, they are not directly connected.

In claim 11, the essential structural cooperative relationship(s) between the “number of electronic communication media” and the “forwarding node” have been omitted, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01. The claim is directed to an apparatus, and therefore, structural cooperative relationships between elements recited in the claims must be set forth according to MPEP 2172.01. MPEP 2172.01 clearly states that “a claim which fails to interrelate (emphasis added) essential elements of the invention as defined by applicant(s) in the specification may be rejected under 35 U.S.C. 112, second paragraph, for failure to point out and distinctly claim the invention. See *In re Venezia*, 530 F.2d 956, 189 USPQ 149 (CCPA 1976); *In re Collier*, 397 F.2d 1003, 158 USPQ 266 (CCPA 1968). It is clear that various recited elements function simultaneously, are directly functionally related, directly intercooperate, and/or serve independent purposes. Since the “number of electronic communication media” and the “forwarding node” are essential elements as defined by the originally filed specification, their structural cooperative relationships must be provided in the claims. If Appellants do not agree with the Examiner that the so-called “number of electronic communication

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media" and the "forwarding node," as defined by the specification, are not essential elements to the claimed invention. Appellants are required to state on the record that this is the case. Further, in view of MPEP 2172.01, it is clear that a claim may be rejected for failing to interrelate essential structural cooperative relationships if various recited elements, as disclosed, function simultaneously, are directly intercooperate, and/or serve independent purposes. In the instant case, the "elements," identified above by the Examiner, function simultaneously, are directly functionally related, directly intercooperate, and/or serve independent purposes as evidenced from the originally filed specification. If Appellants disagree, it is requested that Appellants provide evidences showing that the identified elements do not function simultaneously, are not directly functionally related, not directly intercooperate, and/or not serve independent purposes; and states on the record that this is the case.

In claim 13, it is unclear what may be "an electronic device." There are only first and second devices recited in claim 1; and the relationship(s) between the "electronic device" and first and second devices have not been clearly set forth.

In claim 15, the essential structural cooperative relationship(s) between the "first electronic device" and "the second electronic device" have been omitted, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01. The claim is directed to an apparatus, and therefore, structural cooperative relationships between elements recited in the claims must be set forth according to MPEP 2172.01. MPEP 2172.01 clearly states that "a claim which fails to interrelate (emphasis added) essential elements of the invention as defined by

applicant(s) in the specification may be rejected under 35 U.S.C. 112, second paragraph, for failure to point out and distinctly claim the invention. See *In re Venezia*, 530 F.2d 956, 189 USPQ 149 (CCPA 1976); *In re Collier*, 397 F.2d 1003, 158 USPQ 266 (CCPA 1968). It is clear that various recited elements function simultaneously, are directly functionally related, directly intercooperate, and/or serve independent purposes. Since the “first electronic device” and “the second electronic device” are essential elements as defined by the originally filed specification, their structural cooperative relationships must be provided in the claims. If Appellants do not agree with the Examiner that the so-called “first electronic device” and “the second electronic device,” as defined by the specification, are not essential elements to the claimed invention, Appellants are required to state on the record that this is the case. Further, in view of MPEP 2172.01, it is clear that a claim may be rejected for failing to interrelate essential structural cooperative relationships if various recited elements, as disclosed, function simultaneously, are directly intercooperate, and/or serve independent purposes. In the instant case, the “elements,” identified above by the Examiner, function simultaneously, are directly functionally related, directly intercooperate, and/or serve independent purposes as evidenced from the originally filed specification. If Appellants disagree, it is requested that Appellants provide evidences showing that the identified elements do not function simultaneously, are not directly functionally related, not directly intercooperate, and/or not serve independent purposes; and states on the record that this is the case. Further, the term “set electronic devices” (page 28, line 4) lacks clear antecedent basis. It is unclear whether

there is another set "electronic devices" in addition to the first and second electronic devices.

**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Ex. Khanh Dang



Khanh Dang  
Primary Examiner

Conferees:

Copy of Notice of Panel Decision from Pre-Appeal Brief Review is attached.